



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

David L. Parker
FULBRIGHT & JAWORSKI L.L.P.
Suite 2400
600 Congress Avenue
Austin TX 78701

COPY MAILED

MAR 28 2008

OFFICE OF PETITIONS

In re Patent No. 7,098,248 : DECISION ON REQUEST
David Herndon : FOR RECONSIDERATION OF
Issue Date: August 29, 2006 : PATENT TERM ADJUSTMENT
Application No. 09/901,429 : and
Filed: July 9, 2001 : NOTICE OF INTENT TO ISSUE
Atty Docket No. CLFR:218US : CERTIFICATE OF CORRECTION

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d), filed October 27, 2006. Patentees request that the patent term adjustment as indicated in the issued patent be corrected from four hundred forty-three (443) days to six hundred thirty-five (635) days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED to the extent indicated herein.**

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of five hundred seventy **(570)** days.

Patentees are given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On August 29, 2006, the application matured into U.S. Patent No. 7,098,248, with a revised patent term adjustment of 443 days. On October 27, 2006, patentees timely submitted this request for

reconsideration of patent term adjustment (with required fee), requesting that the Patent Term Adjustment be extended to 635 days. Patentees dispute the reductions of 72 days and 120 days both entered pursuant to 37 CFR 1.704(c)(10) for the filing of "miscellaneous incoming letters." Citing MPEP §2732 and 1247 Off. Gaz. Pat. Office 111 (June 26, 2001), patentees assert that these papers are not a delay by Applicant.

MPEP 2732:

Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). The submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" and (7) letters related to government interests (e.g., those between NASA and the Office).

A review of the letters filed September 26, 2005 and December 7, 2005, confirm that the papers filed were equivalent to a Fee Transmittal (i.e., a required request to apply the previous fee transmittal to a new Notice of Allowance) and a change of status (small/not small entity status). Thus, no reduction was warranted. Accordingly, the reductions of 72 days and 120 days have been removed.

However, a review of the record also reveals that a Petition to Withdraw from Issue, a Request for Continued Examination and an Information Disclosure Statement were filed on April 28, 2005, and an Information Disclosure Statement (IDS) was filed on June 3, 2005. Neither of the IDSs included a §1.704(d) statement. All of these papers were filed after the mailing of the Notice of Allowance on November 18, 2004 and payment of the Issue Fee on February 22, 2005. The entry of a reduction of 69 days,

pursuant to § 1.704(b) is incorrect. This applicant delay was pursuant to 37 CFR 1.704(c)(10). Accordingly, considering overlap, the period of applicant delay is 134 days, counting the number of days in the period beginning on April 28, 2005 and ending on September 8, 2005, the date of mailing of the new Notice of Allowance in response. The period of reduction associated with the filing of the RCE of 134 days has been entered, while a period of reduction of 69 days has been removed.

In view thereof, the patent should have issued with a patent term adjustment of five hundred seventy (570) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The fee is required and will not be waived.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by five hundred seventy (570) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Attachment: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,098,248 B2
DATED : August 29, 2006
INVENTOR(S) : Herndon

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 443 days

Delete the phrase "by 443 days" and insert – by 570 days--